

## REMARKS

Receipt is acknowledged of the Office Action of November 4, 2004. Claims 1-8 are currently pending in the application. Claims 1-8 have been rejected in the Office Action. Applicants amended independent Claims 1 and 4 and request reconsideration of the rejection, as explained in more detail below.

Claims 1-8 were rejected by the Examiner under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,244,934 ("Miyai et al.") in view of U.S. Patent No. 5,964,644 ("Rhoades"). According to the Examiner, Miyai et al. discloses "a method for blasting an inside surface of a cylinder for an internal combustion engine by a blast gun (1), which is provided so as to be moved vertically and rotating around the axis thereof, having a blast nozzle (3) for blowing blast particles (2). The blowing direction of the blast nozzle (3) is slant downward. The blasting is for roughening the inside surface." Further, according to the Examiner, "Rhoades teaches that blasting is typically employed to roughen surfaces to aid in the adherence of applied coatings or adhesive bonding to such surfaces, and that abrasive water jets have grown to be widely employed in cutting and machining operations, particularly with metal sheet and plates to effect rapid and economical cutting and related forming operations." The Examiner believes that it would have been obvious to one of ordinary skill in the art to modify the invention of Miyai et al by employing water jet as taught by Rhoades to remove burrs.

Applicant respectfully disagrees with the Examiner and directs the Examiner's attention to 35 U.S.C. §103(a) and currently amended claims. Applicants amended Claims 1 and 4 to more particularly claim the Applicants' finishing method. Specifically, Claims 1 and 4 now recite the step of smoothing tooth surfaces of the rotor or stator stack by spraying the high

pressure liquid jet onto the tooth surfaces of the rotor/stator stack such that the burrs remaining on the tooth surfaces are removed.

In accordance with MPEP §2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Under MPEP §2143.01, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Moreover, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness.

As the Examiner correctly recognized in the Office Action, Miyai et al. teaches a method of roughening an inner surface of a cylinder by blasting this surface with blasting particles. If the method of Miyai et al. was modified, as suggested by the Examiner, to perform the finishing method of the presently claimed invention, the Miyai et al. method would result in obtaining a smooth inner surface of the cylinder. This will render Miyai et al. unsuitable for its intended purpose of obtaining a rough surface. Therefore, there is no sufficient suggestion or motivation for combining or modifying the teachings of Miyai et al. and Rhoades to produce the claimed method of finishing the stator/rotor stack including the step of smoothing tooth surfaces of the rotor or stator stack by spraying the high pressure liquid jet onto the tooth surfaces of the rotor/stator stack such that the burrs remaining on the tooth surfaces are removed.

Further, MPEP §2143.03 reiterates that to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP 2143.01 specifically states that "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness," and that "fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness."

Neither Miyai et al. nor Rhoades disclose the step of "smoothing said tooth surfaces of said stator stack by spraying said high pressure liquid jet onto said tooth surfaces of said stator stack such that said burrs remaining on said tooth surfaces are removed" of the

amended Claim 1. Similarly, none of the currently cited references disclose the limitation of the amended Claim 4 of "smoothing said tooth surfaces of said rotor stack by spraying said high pressure liquid jet onto said tooth surfaces of said rotor stack such that said burrs remaining on said tooth surfaces are removed." Therefore, Claims 1 and 4, as amended, can not be rendered obvious by the prior art of record because even if the Miyai et al reference is combined with the Rhoades reference, at least the above referenced limitations of Claims 1 and 4 are not taught by this combination. Further, these limitations are not even suggested by the combination of the two cited references.

Based on the above, Claims 1 and 4 are believed to be patentable over the prior art of record. Applicants respectfully submit that dependent Claims 2-3 and 5-8 are believed to define patentable subject matter in view of their dependency upon allowable Claims 1 and 4 and, further, on their own merits.

Claims 1- 8 were further rejected by the Examiner under 35 USC §112, second paragraph, as being indefinite. Applicants amended Claims 1, 4 and 8 to claim the invention with more particularity.

In response to the Examiner's objection to the drawings, Applicants corrected the drawings to show the "central axes" as recited in the claims. Replacement drawings for Figures 2, 3 and 5 are enclosed herewith (a marked-up copy of Figs. 2, 3 and 5 are also enclosed.

The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that any extension of time is required, Applicant petitions for that extension of time required to make this response timely.

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Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-0675, Order No. 051319-53.

Respectfully submitted,

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